

IPW

PATENT  
Docket No. 4655-4000



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant(s): Peter Littlewood et al.

Group Art 2627

Serial No.: 10/791,090

Examiner: Matthew KAYRISH

Filed: March 1, 2004

For: MAGNETIC FIELD SENSOR

**RESPONSE TO ELECTION/RESTRICTION REQUIREMENT**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

In response to the Election/ Requirement mailed April 6, 2006 in above-identified application, kindly consider the following election:

**ELECTION:**

The Examiner, in the Office Communication dated April 6, 2006, requires election of one of the following species:

Species I: drawn to Figure 1;

Species II: drawn to Figure 2a;

Species III: drawn to Figure 2b;

Species IV: drawn to Figure 3a; and

Species V: drawn to Figure 4.

The Applicants respectfully traverse the above election of species requirements as being improper and request withdrawal thereof.

Section 803 of the Manual of Patent Examining Procedure (MPEP) requires two criteria to be met for a proper requirement for restriction between patentably distinct inventions, as follows:

- (A) The inventions must be independent or distinct as claimed, and
- (B) There must be a serious burden on the examiner if restriction is not required.

MPEP §803; see also MPEP §§ 806.05(j), 808.01, 808.02 and 809.02.

The Applicants respectfully submit that the above-noted Species I-V are properly presented in the same application and that no serious burden on the Examiner exists. The Examiner has not provided any evidence or line of reasoning to show that the identified species are independent and that a serious burden exists. See MPEP §803 (stating that “Examiners **must** provide reasons and/or examples to support conclusions . . .”)(emphasis added); MPEP §808.01 (stating that “[t]he particular reasons relied on by the examiner for holding that the inventions as claimed are either independent or distinct should be concisely stated. A mere statement of conclusion is inadequate.”). As such, the Examiner has not satisfied the two criteria identified in Section 803 of the MPEP.

Notwithstanding any actual independence or distinction between the identified species, Section 803 of the MPEP requires examiners to search and examine application containing independent or distinct invention when no serious burden to do so exists. Section 803 of the MPEP also states that:

If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.

The Examiner has not provided any specific discussion, line of reasoning, and/or evidence to support his conclusion that a serious burden, in fact, exists.

In view of the above discussion, it is respectfully submitted that the election of species requirement is improper and should be withdrawn. Accordingly, action on the merits for Species I-V (Claims 1-41) is respectfully requested.

Notwithstanding the above discussion, the Applicants hereby provisionally elect Species I which reads on at least claims 1-11, 13-21, 23-26, 29-34, 40 and 41. Claims 1-3, 5-10, 13-21, 24, 25, 29, 32-34, 40 and 41 are believed to be generic to ALL species I-V. In the event a generic claim is allowed, the Applicants respectfully request consideration of the claims of any non-elected species. The Applicants also reserve the right to file divisional applications based on the non-elected species and claims directed thereto.

If any issues exist, or if the Examiner has any suggestions for expediting allowance of the application, the Examiner is invited to contact the undersigned at the telephone number below.

AUTHORIZATION

The Commissioner is hereby authorized to charge any additional fees which may be required for timely consideration of this paper, or credit any overpayment to Deposit Account No. 13-4500, Order No. 4655-4000.

Respectfully submitted,  
MORGAN & FINNEGAN, L.L.P.

Dated: 6/6/06

By:

  
James Hwa  
Registration No. 42,680  
(202) 857-7887 Telephone  
(202) 857-7929 Facsimile

Correspondence Address:

MORGAN & FINNEGAN, L.L.P.  
3 World Financial Center  
New York, NY 10281-2101